

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB**

Hearing:  
February 19, 2004

Mailed: May 13, 2004  
Paper No. 26  
PTH

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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R.C.S. Periodici S.P.A.  
v.  
Max H. Schwartz

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Opposition No. 91110915  
to application Serial No. 75348849  
filed on August 28, 1997

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Frank P. Presta of Nixon & Vanderhye P.C. for R.C.S.  
Periodici S.P.A.

Todd E. Stockwell of Stockwell & Associates for Max H.  
Schwartz.

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Before Simms, Quinn and Hairston, Administrative Trademark  
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Max H. Schwartz to  
register the mark shown below,



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for a "magazine expressly for readers over thirty years of age featuring topics about their lifestyles and on medicine, health, exercise and diet."<sup>1</sup>

Registration has been opposed by R.C.S. Periodici S.P.A. under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks MAX for "adult entertainment magazines";<sup>2</sup> and MAX GENERATION for "general feature magazines, entertainment magazines, computer magazines, travel magazines, [and] technical magazines,"<sup>3</sup> as to be likely to cause confusion.

Applicant, in his answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; certified copies of opposer's pleaded registrations (Registration No. 1,361,812 was submitted with the notice of opposition and Registration No. 2,261,784 was submitted under notice of reliance); and the affidavit of applicant Max H. Schwartz pursuant to the parties' stipulation.

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<sup>1</sup> Application Serial No. 75348849, filed August 28, 1997, alleging first use on April 12, 1996 and first use in interstate commerce on June 12, 1996. The word "MAGAZINE" is disclaimed apart from the mark as shown.

<sup>2</sup> Registration No. 1,361,812 issued September 24, 1985; Section 8 affidavit filed; Section 15 affidavit acknowledged.

<sup>3</sup> Registration No. 2,261,784 issued July 20, 1999. Although this registration covers other printed publications as well as other types of goods, opposer relies solely on the identified magazines.

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Because the only evidence opposer submitted were copies of its pleaded registrations, we have little information about opposer.

Applicant, in his affidavit, states that his magazine is intended for people over the age of 19; that his magazines and opposer's magazines have been distributed in overlapping geographical areas; that he is not aware of any instances of actual confusion; and that at the time he began use of his mark, he had no knowledge of opposer's MAX mark.

There is no issue as to opposer's priority in view of opposer's registrations for the marks MAX and MAX GENERATION, which it has made of record. *King Candy v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.

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Because opposer's MAX mark is the most similar to applicant's MAX MAGAZINE and design mark, we turn to a determination of the likelihood of confusion with respect to these marks.

With respect to the parties' goods, applicant argues that the goods are different in nature because his magazine is "more of a general interest magazine for middle-aged and older people" whereas opposer's magazine is "used with racier material." (Brief, p. 5).

The question of likelihood of confusion must be determined on the basis of the goods as they are set forth in opposer's registration and applicant's application, and not in light of what such goods are shown or asserted to actually be. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services be related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they

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originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. In re Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

We find that, based on the identification of goods, applicant's magazine expressly for readers over thirty years of age featuring topics about their lifestyles and on medicine, health, exercise and diet and opposer's adult entertainment magazines are closely related goods. Of course, both the applicant's and registrant's goods are magazines. The identification of opposer's goods (adult entertainment magazines) is broad enough that such magazines may include articles on topics such as lifestyles, medicine, health, exercise and diet. Further, both applicant's identified magazine and opposer's identified magazine would be sold in the same channels of trade, namely bookstores and magazine stands, to the same class of purchasers, namely adults. Thus, the marketing of the respective magazines under the same or similar marks would be likely to cause confusion as to source or sponsorship.

Turning then to a consideration of the marks, we are, of course, compelled to compare the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in so doing, it is well settled that one feature of a mark may be more

significant than another and it is not at all improper to give weight to the more dominant feature of a mark. For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ..." National Data, 224 USPQ at 751.

The disclaimed word MAGAZINE in applicant's mark is generic for applicant's goods, namely, magazines. As for the rectangular design portion in applicant's mark, it is clear that such common geometric shapes have little or no source-identifying significance. 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 7:29 at page 7-47 (4<sup>th</sup> ed. 2002). Thus, contrary to applicant's contention, the rectangular design is not the dominant portion of applicant's mark. Rather, it is the word MAX, which is identical to opposer's mark in its entirety. We find that applicant's mark MAX MAGAZINE and design and opposer's mark MAX, when considered in their entirety, are substantially similar in sound, appearance, connotation and commercial impression.

Purchasers familiar with opposer's adult entertainment magazines offered under the mark MAX, upon encountering applicant's magazine offered under the mark MAX MAGAZINE and design, are likely to assume that opposer is offering a new type of magazine.

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We note that applicant states in his affidavit that he is not aware of any instances of actual confusion, although the parties have used their respective marks in overlapping geographical areas. However, there is nothing in the record regarding the extent of use (e.g., sales and advertising figures) of either opposer's mark MAX or applicant's mark MAX MAGAZINE and design. Thus, we do not know if there has been any meaningful opportunity for confusion to occur in the marketplace.

In sum, we conclude that applicant's mark MAX MAGAZINE and design, when applied to magazines expressly for readers over thirty years of age featuring topics about their lifestyles and on medicine, health, exercise and diet, so resembles opposer's registered mark MAX for adult entertainment magazines, as to be likely to cause confusion.

In view of our finding, we need not reach the issue of likelihood of confusion between opposer's mark MAX GENERATION and applicant's mark MAX MAGAZINE.

**Decision:** The opposition is sustained.